The objection to claim 2 is respectively traversed in view of the above amendments.

The rejection of claims 1-17, 23 and 24 under 35 USC § 101 for lack of utility is respectfully traversed.

The rejection of claims 1-6 and 20-24 under 35 U.S.C. §101 for lack of utility is respectfully traversed.

The claims of the above-identified patent application have a specific, substantial and credible asserted utility. As described in the specification as filed the proteins of the present invention have transcriptional regulatory activity (pg. 29, lines 25-30, pg. 15, lines 17-18, pg. 41, line 29-pg. 43, line 32.)

Accordingly, the specification identifies an asserted utility. Therefore, the PTO must determine if the asserted utility is specific, substantial and credible. (Manual of Patent Examining Procedure ("MPEP") 2107(B)). Only one credible asserted utility is needed to meet the criteria for 35 USC § 101 (MPEP 2107(B)(1)(ii)). Further, an applicant's asserted utility creates a presumption of utility that is sufficient to satisfy the utility requirement of 35 USC § 101 (MPEP 2107.02 III). If the asserted utility is credible, a rejection based of lack of utility is not appropriate (Id.).

In particular, the application as filed describes the transcriptional regulatory activity of the protein (pg. 29, lines 25-30, pg. 15, lines 17-18, pg. 41, line 29-pg. 43, line 32.) As shown in the example, the *GAL4-TIG-1* expression plasmid showed a threefold increase in CAT expression when compared to CAT activity of the GAL4 DNA binding domain (pg. 42, lines 11-30). Further, TPA induced K562 cells cotransfected with the *CAT* reporter construct and the GAL4-TIG-1 expression vector increase CAT expression by 11-14 fold as compared to uninduced cells (pg. 43, lines 1-12; Figure 7C). In addition, the structure of the protein of the present invention is similar to a co-activator complex that mediates chromatin-directed transcriptional activation (pg. 44, lines 3-13).

Accordingly, because there is no reason to doubt the assertion that the proteins of the present invention have transcriptional regulatory activity and that such proteins have a well-established utility, applicants asserted utility for the present case is sufficient to meet the utility requirement of 35 USC § 101. No further experimentation is necessary to attribute a utility to the claimed proteins. See *Brenner v. Manson*, 383 US 519, 148 USPQ 689 (1966). Accordingly, the rejection of claims 1-17, 23 and 24 for lack of utility is improper and should be withdrawn.

The rejection of claims 1-17, 23 and 24 under 35 U.S.C. §112 (first paragraph) for lack of written description is respectfully traversed for the same reasons as argued above to overcome the lack of utility rejection. Accordingly, this rejection should be withdrawn.

In view of the foregoing, applicants submit that this case is in condition for allowance and such allowance is earnestly solicited.

Pursuant to 37 CFR §§ 1.97-1.98, applicants submit herewith to the U.S. Patent and Trademark Office copies of the references listed on the attached PTO-1449 form. Enclosed is a check for $180 for submission of the Information Disclosure Statement. The Commissioner is hereby authorized to credit any overpayment of charge any fee owing to Deposit Account 50-0772.

Respectfully submitted,

November 12, 2002
Date

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Karla M. Weyand

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Appendix (marked-up version of abstract, specification and claims):

ABSTRACT OF THE DISCLOSURE

The present invention is directed to isolated nucleic acid molecules encoding protein, wherein the protein has transcriptional activator activity. Expression vectors and host cells comprising the nucleic acid molecules are also provided, as well as methods for increasing or decreasing the expression of the transcriptional activator protein in host cells. The invention further provides methods of screening a substance for the ability of the substance to modify transcriptional activator protein function, and a method for isolating other transcriptional activator protein molecules. [DNA oligomers capable of hybridizing to the nucleic acid molecule encoding the transcriptional activator protein are provided, which can be used to detect transcriptional activator protein in a sample. Antibodies specific for the transcriptional activator protein, and fragments thereof, are provided.]

(Specification, page 15, lines 25-31)

An example of the protein is the protein encoded by the nucleotide sequence as shown in SEQ ID NO:1 (this is the open reading frame). The amino acid sequence encoded by this nucleotide sequence is shown in SEQ ID NO:3. The full nucleotide sequence is as shown in SEQ ID NO:2. [The amino acid sequence encoded by this nucleotide sequence is shown in SEQ ID NO:4.]

Claims:

1. (Amended) An isolated nucleic acid molecule <u>wherein said nucleic acid molecule encodes an amino acid sequence as shown in SEQ ID. NO:3</u> [having a nucleotide sequence as shown in SEQ ID NO:1].

2. (Amended) The isolated nucleic acid molecule of claim 1 wherein said nucleic acid molecule <u>has a nucleotide sequence as shown in SEQ ID NO:1</u> [encodes an amino acid sequence as shown in SEQ ID NO:3].